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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,495	10/07/2003	Soren Riise	1085-053-PWH	5522

60597 7590 12/21/2007
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EXAMINER	
MANCHO, RONNIE M	

ART UNIT	PAPER NUMBER
3663	

MAIL DATE	DELIVERY MODE
12/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

Office Action Summary	**Application No.** 10/680,495	**Applicant(s)** RIISE ET AL.	
	Examiner Ronnie Mancho	**Art Unit** 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2007*.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.
  4a) Of the above claim(s) *13,14,17 and 18* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-12,15,16 and 19-21* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☒ All b)☐ Some * c)☐ None of:
    1.☒ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12, 15, 16, 19-21 are rejected under 35 U.S.C. 101 because in independent claim 1, applicant does not disclose a tangible result in the invention. Applicant recites entering "locality name". Then applicant further recites "returning, in dependence on the locality name, a probability". There is no tangible result in returning a probability. The body of the claim does not provide the use or purpose for returning a probability.

Applicant should amend the claims to show how "returning a probability" can be used for accomplishing a purpose, thus providing a tangible result.

The rest of the claims are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19, 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 19, the limitation, “separating”, “text criteria that is not locality name” is new matter because the original disclosure does not recite the limitation.

In claim 21, the limitation, “search results that are refined in a manner corresponding to the returned probability” is new matter because the original disclosure does not recite the limitation.

4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 21 recites, "search results that are *refined in a manner* corresponding to the returned probability”. The disclosure is insufficient in defining how and in what manner the search results are refined. The disclosure is insufficient in defining the “manner” applicant is referring to? One skilled in the art will not be able to ascertain the limitation since it is not enabled in disclosure.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12, 15, 16, 19, 20, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 1 recites, "using processing *means*", emphasis added. It is noted that the term, "means" as claimed does not particularly and distinctly indicate if he invention is a method or apparatus. Thus the limitation does not limit the scope of the claim. See MPEP 2106. The "means" clause should be deleted because it is to be used in apparatus claims.

Applicant further recites "submitting, ---------- a locality name". If the information is submitted, why is it returned?

Claim 11 recites, "a look-up table that associates the locality names and geographic locations". To what is the locality name and geographic name associated to?

In claim 19, the limitation, "may be" constitutes language that suggests or makes optional but does not require steps to be performed or does not limit the scope of the claim. See MPEP 2106 R5, II.

The rest of the claims are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12, 15, 16, 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dupray.

Regarding claim 1, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses a method of determining a likely geographical location (col.

27, lines 44-48) for which a user of a computer desires further information based on submitted criteria comprising the steps of:

the user submitting criteria including a locality name (col. 27, lines 1-67; col. 46, lines 47-67);

identifying from the criteria the locality name (col. 27, lines 1-67; col. 46, lines 47-67);

returning, using processing means 1356 (fig. 5; col. 46, lines 21-54, location estimates are probabilities) and in dependence on the locality name, a probability (col. 6, lines 58-67) that the locality name is associated with a geographical location (col. 21, lines 1-10).

A criteria of a locality name includes a request to know if a truck is in a given locality name, e.g. Denver area. See for example fig. 4. The truck or mobile station 140 is in an area 120. The area 120 has a specific geographic code or name to identify the area 120 (col. 19, lines 6-42). The area 120 is divided into many cells such cell location 122A, 122B, 122C, etc. The cell locations also have their own specific identification code identifying the particular cell are 122A, 122B, 122C, etc (col. 19, lines 6-42). Therefore, the probability that mobile station 140 is in area 120 is the same probability that cell location are 122A or 122B, or 122C, etc is in the geographic area 120 (col. 6, lines 62 to col. 7, line 5). This so because when mobile station 140 is the cell area 122A, or 122B, or 122C, etc the location of the mobile station is the same location as the cell are 122A, or 122B or 122C. Therefore, the probability that cell area 122A or 122B, or 122C is associated with geographic are 12o if the probability that mobile station 140 is associated with geographic location of are 120 such as the Denver area (col. 46, lines 47-54; col. 27, lines 44-48; col. 28, lines 18-21, lines 35-40).

Regarding claim 2, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the returned probability (col. 6, lines 58-67) indicates the probability that the locality name is associated with each of a plurality of geographic locations

Regarding claim 3, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the search criteria includes a plurality of locality names and the method comprises the steps of:

identifying each of the locality names and returning, in dependence on each locality name, a probability (col. 6, lines 58-67) that each of the locality names is associated with a geographical location; and

combining the returned probabilities (see probabilities, dual estimate; col. 6, lines 45-67) to return a composite probability (see probabilities, dual estimate; col. 6, lines 45-67) that the plurality of location names is associated with a geographical location (col. 6, line 45 to col. 7, line; col. 29, line 59 to col. 30, line 28).

Regarding claim 4, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 3, wherein the returned composite probabilities indicate the probability of each of a the locality names being associated with each of a plurality of geographic locations (col. 6, line 45 to col. 7, line).

Regarding claim 5, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 3, wherein the returned probability is derived from a combination of each of the probabilities returned for each of the locality names.

Regarding claim 6, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein a set of probabilities are provided between a plurality of locality names and a plurality of geographic locations, there being a probability linking a locality name to one or more of the geographic locations.

Regarding claim 7, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the computer of the user is part of a network and has a network address, the network address being mapped to a geographical location, the method comprising the further step of weighting a returned probability in dependence on the mapped geographical location indicated by the network address.

Regarding claim 8, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 7, wherein the network is the Internet and the network address is the IP address of the computer.

Regarding claim 9, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col..21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the computer is one of the group consisting of: a desktop PC, a portable PC, a Personal Digital Assistant (PDA), a mobile telephone and a mobile communication device.

Regarding claim 10, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, comprising the further step of making a determination as to the geographic location being sought by the user in response to the or each returned probability.

Regarding claim 11, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the returning step includes selecting the returned probabilities from probabilities stored in a look-up table (Table LH-1, col. 28; also see figs. 9A&B, etc) that associates the locality names and geographic locations.

Regarding claim 12, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the probability is returned as a probability vector (col. 29, lines 59 to col. 30, line 28).

Regarding claim 15, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the of each returned probability is open to weighting by a genetic algorithm (col. 29, lines 59 to col. 30, line 28).

Regarding claim 16, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method of determining a likely geographical location of a network user based on criteria submitted by the user, the method comprising the steps of:

holding, in a location module, geographic location information mapped from a user's computer network address [see databases in figs. 6(2) and 6(3)];

monitoring submitted criteria including a locality name (col. 21, lines 41-67; col. 27, lines 1-67);

determining if the locality name is a sub-location within the geographic location indicated by the geographic location information mapped from a user's network address col. 21, lines 41-67; col. 27, lines 1-67; col. 28);

refining (col. 47, lines 14-37) the geographic location information mapped from a user's network address to indicate a probability (col. 6, lines 58-67) that the user is located in the sub-location.

Regarding claim 19, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 1, wherein the criteria may be in the form of text and wherein the identifying step includes separating the text criteria that is not locality name from text criteria this locality name (see data structure, col. 27, lines 61 to col. 28, line 67; col. 46, lines 47-67).

Regarding claim 20, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 19, wherein the returning step includes providing information to the user based on upon the returned probability (col. 27, lines 61 to col. 28, line 67; col. 46, lines 47-67).

Regarding claim 21, Dupray (abstract, figs. 4, 5-8, 9, 11; col. 20, lines 33-67; col. 21, lines 41-67; col. 27, lines 1-67) discloses the method according to Claim 20, wherein the provided information comprises search results that are refined in a manner corresponding to the returned probability (col. 27, lines 61 to col. 28, line 67; col. 46, lines 47-67).

Response to Arguments

9. Applicant's arguments filed 9/21/07 have been fully considered but they are not persuasive.

Applicant argues that the claims meet 35 USC 101 requirements. The examiner disagrees. Applicant's explanations are off point as it appears that applicant argument is not directed to the basis of the 101 rejection questioning the purpose of "returning, in dependence on the locality name, a probability". The rejection does not question whether there is a proper application of a mathematical algorithm. Applicant does not disclose a tangible result when returning probabilities as claimed. One skilled in the art following the steps recited in claim 1 will not be able to determine a geographical location. Applicant needs to show how to determine a geographical location in relation to "returning probabilities" to overcome the rejection. If the claims are amended as such, the amendments should be consistent with the original disclosure.

Applicant further requests that the 112 rejection drawn to "missing steps" in the claims should be withdrawn in view of the amendments. The examiner notes that the amendments do not correct the deficiencies cited in the 112 rejections. That is applicant needs to consider the questions posed in the rejection and correct the deficiencies in the claim. The amended claim still has missing steps. That is in claim 1, the applicant recites "returning, --------- in dependence on the locality name, a probability". Claim 1 appears to be incomplete and has missing steps. The purpose for returning a probability is not particularly and distinctly recited in the claims. The 112 rejection was not about whether there was a proper application of a mathematical algorithm. Instead, the 112 rejection was about a missing step in the claims. The 112 rejection was also about the limitation, "submitting, ---------- a locality name". If the information is submitted, why is it returned? Applicant in the reply has not responded to the questions. That is when the locality name is entered, and a probability is returned as argued, applicant does not disclose the *purpose* for entering a locality name and returning a probability.

Applicant further argues that the prior art does not disclose "submitting criteria including a locality name". The examiner disagrees. The prior art (col. 27, lines 1-67; col. 46, lines 47-67) anticipates the limitation. As an example, a trucking company submits a criteria, which criteria includes a locality name --Denver---. The criteria which includes and is the locality name, --Denver-- is submitted to a location station or center 142 through the internet to know if a particular truck is in the locality name, --Denver--. Applicant further argues that the prior art does not identify from the criteria, a locality name. The examiner disagrees. As already mentioned, the trucking company submits a criteria to know if a truck is located in a locality name, --Denver--. Thus the locality name, --Denver-- has been identified from the criteria as claimed. Therefore, the prior art anticipates the limitation. Applicant further argues that the prior art "does not transmit a locality name to any of the other components in the system", etc. It is noted that this particular limitation is not claimed. Applicant is reading limitations from the specification into the claims. This is not permitted. See MPEP 2106.

Applicant further argues that the prior art does not disclose the step of "returning......in dependence on the locality name, a probability of the locality name being associated with a geographical location". The examiner disagrees. In the prior art (figs. 4& 5; col. 46, lines 48-54) a criteria is submitted through the internet requesting a location estimate. Estimate is also known as probability. The criteria include a request to know if a truck is in a locality name, e.g. Denver area. See for example fig. 4. The truck or mobile station 140 is in an area 120. The area

120 has a specific geographic code or name to identify the area 120 (col. 19, lines 6-42). The area 120 is divided into many cells such cell location 122A, 122B, 122C, etc. The cell locations also have their own specific identification code identifying the particular cell are 122A, 122B, 122C, etc (col. 19, lines 6-42). Therefore, the probability that mobile station 140 is in area 120 is the same probability that cell location are 122A or 122B, or 122C, etc is in the geographic area 120 (col. 6, lines 62 to col. 7, line 5). This so because when mobile station 140 is the cell area 122A, or 122B, or 122C, etc the location of the mobile station is the same location as the cell are 122A, or 122B or 122C. Therefore, the probability that cell area 122A or 122B, or 122C is associated with geographic are 12o if the probability that mobile station 140 is associated with geographic location of are 120 such as the Denver area (col. 46, lines 47-54; col. 27, lines 44-48; col. 28, lines 18-21, lines 35-40).

Applicant further argues that the probability in the prior art is not “in dependence on the locality name”, but rather dependent upon the existence of a locality name. The examiner does not understand the purpose of the argument since a probability “dependent on the locality name” is no different from a --probability dependent upon the existence of a locality name--. That is, first the locality has to exist before the locality can have a name. Applicant's arguments appear to be reading limitations from the specification into the claims, the arguments are not on point.

Applicant further argues that claim 16 call for "holding....geographic location information mapped from a user's computer network address", and that the prior art does not anticipate the limitation. The examiner disagrees and notes that the information of the mobile station (MS) such as its longitude, latitude, BS ID, is transmitted from the MS to the location center 142 during communication therewith. The information is then stored in the database 139 as historical data.

Applicant further argues that the probability of the prior art is not refined. It is noted that the term refined is new matter. Applicant does not provide the meaning thereof. It is note that the prior art (col. 47, lines 14-37) disclose refining that probability as claimed.

All other arguments from the applicant are not on point. It is believed that the rejections are proper and thus stand.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663

12/4/2007

Cuongnguyen
CUONG NGUYEN
PRIMARY EXAMINER